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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,194	11/13/2000	Casey William Norman	1391-CIP-00	6427

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EXAMINER	
WILLIAMS, JAMILA O	

ART UNIT	PAPER NUMBER
3722	

MAIL DATE	DELIVERY MODE
05/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/711,194	NORMAN ET AL.	
	Examiner	Art Unit	
	Jamila Williams	3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 September 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-18,20 and 21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-18,20-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. In view of the appeal brief filed on 9-28-2006, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Monica S. Carter
MONICA CARTER
SUPERVISORY PATENT EXAMINER

NOTE: prosecution is being reopened because in the previous office action (3-21-2006) the double patenting rejection was omitted. The examiner is including this portion of the action such that applicant can include the double patenting rejection in the appeal if deemed necessary.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1,4-7,13-16,18, 20,21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 20-21,28-29,31,33-36,38-39,41-42,44 of copending Application No. 09/844322. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are similar in scope and subject matter.

   For example, claim 1 of '322 discloses a garment comprising flexible and elastic injection molded thermoplastic elastomer having a molded shape to fit over in a life-like way external surfaces of at least a portion of a doll that has articulated limbs, has a through hole that accomidates passage of a doll's head or limb(s) and a wall thickness from 1 to 3mm. However claim 1 is lacking a seamless doll's skin and the material repeatedly covers and is removed from the doll. It would have been obvious to one having ordinary skill in the art at the time the invention

was made to make the material of '322 a skin for the purpose of altering the doll and to make the material repeatedly removable for the purpose of allowing the user to interchange the appearance of the doll.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1,6-8,10,13,14,15,16,20,21 are rejected under 35 U.S.C. 103(a) as being obvious over O'Brian et al [2,944,368], hereinafter O'Brian in view of Kramer [5,607,339] and either Gross [5,913,708] or Wion [4,294,036] and further in view of Washburn et al [4,063,402], hereinafter Washburn.

O'Brian discloses in Figs 1-7, a garment or skin [blouse 30] comprising a flexible and elastic molded thermoplastic elastomer [col 3 lines 54-56 and col 4 line 58 and also [[**re·sil·ient** (rî-zîl'yent) *adjective 1.* Capable of returning to an original shape or position, as after having been compressed.] according to Merrian-Webster's Collegiate Dictionary Tenth Edition] doll's garment having a molded shape to fit over external surfaces of at least a portion of a doll [Fig 4], has a through hole [insofar as the applicant has claimed blouse 30 is considered to have a through hole [the opening for the neck for example].

Additionally, please note that O'Brian start with a flat sheet of material, which is then formed into three-dimension article.

Regarding the limitations of the skin or garment being adapted in size to be fitted to and removed from a doll having a specific height (less than 8cm or above 8cm to about 20cm), the garment of O'Brian is inherently capable of this function.

O'Brian does not disclose a doll having articulated limbs, having a doll with a height range of 8-20cm, as recited in claim 15; a doll's garment formed from a flexible sheet of polymer plastic material between 1mm and 3 mm in thickness, as recited in claim 1; a modulus of elasticity of 120-350KN/m^2), as recited in claim 6.

Kramer teaches the concept of providing a doll, a doll's garment or skin (col 1 lines 51-57) formed from a flexible sheet of polymer plastic material between 1mm and 3 mm in thickness and with modulus of elasticity of less than 750 pound per square inch (120-350KN/m^2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the doll's garment of O'Brian to have thickness and with modulus of elasticity as taught by Kramer to provide more flexibility.

Either Gross or Wion teaches that it is conventional to have articulated shoulders, elbows, knees, neck, and hips in a play set comprising a doll and a doll's garment or in a planar doll [two dimensional]. It would have been obvious to further provide the modified device of O'Brian with the articulated doll as disclosed by either Gross or Wion, for the purpose of making the device more realistic and enjoyable for the children to play with.

Washburn teaches that it is conventional to have dolls at a height of 4.5in (approx. 11cm). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the modified device of O'Brian with the articulated doll as taught by Gross or Wion with the height as taught by Washburn for the purpose of providing a more user friendly doll for a young child.

With respect to the **injection** molded thermoplastic elastomer in claims 21-22, is considered to be process steps in product claims. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) [see MPEP 2113 regarding how product by process claims re treated in claims].

6. Claims 3-5,11 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brian et al in view of Kramer and either Gross or Wion as applied above and further in view of Yasuda [5,928,803].

Modified device of O'Brian has most of the elements of these claims but for the specific elastomeric material.

Yasuda discloses using the thermoplastic elastomer containing styrene (col 3 lines 18-54) in order to make clothes for dolls as the constituent element of dolls). It would have been obvious to further make the modified device of O'Brian out of

thermoplastic elastomer-containing styrene as taught by Yasuda in order to give the device more flexibility.

7. Claims 12 are rejected under 35 U.S.C. 103(a) as being obvious over O'Brian et al [2,944,368], hereinafter O'Brian in view of Kramer [5,607,339] and either Gross [5,913,708] or Wion [4,294,036], as applied to claim 10 above and further in view of Fogarty et al [4,414,774], hereinafter Fogarty. O'Brian as modified by Kramer and either Gross or Wion disclose all elements of the claim but for the integrally molded detail. Fogarty teaches molded doll garments having integrally molded details (fig 4,9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use an integrally molded feature of Fogarty with the modified garment or skin of O'Brian for the purpose of making the garment or skin more realistic.
8. Claims 1 and 9 are rejected under 35 U.S.C. 103(a) as being obvious over Yasuda [5,928,803] in view of 5,607,339 to Kramer and further in view of O'Brian et al [2,944,368], hereinafter O'Brian. Yasuda discloses a seamless doll's skin or garment (fig 1) comprising a seamless, molded elastomeric material (col 3 lines 18-54 of the specification) sized and shaped to approximate the size and shape of at least a portion of a doll that is at least partially bendable or articulated which repeatedly covers and is removed from the doll and transforms the doll into a different character or object (inherently capable of this function).

Yasuda does not however disclose the wall thickness of 1-3mm for the doll's skin nor the through hole to accommodate passage of a doll's head or limb(s).

Kramer teaches having seamless doll's skin with a wall thickness of 1-3mm.

O'Brian teaches having a through hole to accommodate passage of a doll's head (for example the opening for the neck/head in figure 4). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the wall thickness as taught by Kramer and the through hole as taught by O'Brian with the skin of Yasuda for the purpose of making a more realistic doll's skin. Regarding the limitation of claim 9, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the material of Yasuda to form an animal since the material is disclosed to be used as fur of stuffed animal toys (col 19 line 62).

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamila O. Williams whose telephone number is 571-272-4431. The examiner can normally be reached on Mon-Fri 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JW 5-11-2007

Monica S. Carter

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SUPERVISORY PATENT EXAMINER